

### REMARKS/AMENDMENTS

Claims 1, and 3-65 are pending and at issue. Claim 2 has been cancelled without prejudice or disclaimer. Claim 1 has been amended to incorporate the claim limitations of claim 2 into claim 1. Claim 65 has been added.

The Examiner has indicated in the Office Action that claims 2-4, 6, 7, 49, 52,53, and 59-61 are allowable.

Claims 1 and 5 are rejected as anticipated under 35 U.S.C. §102(b) by Bender et al. (U.S. Patent No. 2,858,342). This rejection is traversed and reconsideration is respectfully requested.

Claim 1 has been amended to incorporate the limitations of claim 2 into claim 1. Since the Examiner has already determined that claim 2 is allowable, claim 1, as amended, is not anticipated by Bender et al. Claim 5 is dependent from Claim 1 and is not anticipated for at least the same reasons.

Applicants respectfully request withdrawal of this rejection.

Claims 44-46, 51, 57, and 58 are rejected as obvious under 35 U.S.C. §103 (a) over DaiNippon Inc. Chem. KK, hereinafter "DaiNippon" (JP 60261639A). The Examiner contends that DaiNippon discloses charging a mixture of phenol, bisphenol and formalin to a flask, adding KOH as a catalyst, and raising the temperature to 80°C, the reaction taking place to reach a water tolerance of 500%, after which the mixture is cooled, neutralized to 6.5-7.0 pH, and submitted to distillation to obtain bisphenol F modified phenol formaldehyde resin precondensate. The Examiner concludes that it would have been obvious to one skilled in the art at the time of the invention to add bisphenol after the water tolerance of 500% is reached in DaiNippon instead of including it in the original reactants because selection of any order of mixing of ingredients is prima facie obvious in the absence of new or unexpected results.

This rejection is traversed, and reconsideration is respectfully requested.

Claim 44 recites "adding a bisphenolic compound to the reaction product when the water tolerance is from about 400% to about 1100%." Applicant respectfully points out that DaiNippon does not expressly disclose that their reaction mixture reaches a water tolerance of 500%, nor does DaiNippon teach the importance of adding a bisphenolic compound to the

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reaction product when the range of water tolerance is from about 400% to about 1100%. Since DaiNippon does not teach a reaction mixture having a water tolerance of 500%, claims 44-46, 51, 57, and 58 are not obvious in light of this reference.

In light of the above, Applicants respectfully request withdrawal of this rejection.

Claims 47 and 48 are rejected under 35 U.S.C. §103(a) as obvious over DaiNippon as applied to claims 44-46, 51, 57, and 58 above, and further in view of Kreibich et al (Re 26,881). The Examiner asserts that it would have been obvious to one skilled in the art at the time of the applicants' invention to substitute the NaOH or calcium acetate of Kreibich et al for KOH in DaiNippon because Kreibich et al disclose the use of NaOH and calcium acetate in making similar phenol-formaldehyde resins and DaiNippon contemplates any alkali metal and/or alkaline earth metal compound as a catalyst.

As discussed above, DaiNippon does not expressly disclose that their reaction mixture reaches a water tolerance of 500%. Additionally, neither DaiNippon nor Kreibich et al. teach the importance of adding a bisphenolic compound to a mixture after the mixture has reached a water tolerance of about 400 to about 1100%. Since neither reference does not teach the importance of adding a bisphenolic compound to a reacting resole resin when the water tolerance is about 400 to about 1100 %, combining the references does not yield the invention claimed by claims 47 and 48.

In light of the foregoing, Applicants respectfully request withdrawal of this rejection.

Claim 50 is rejected under 35 U.S.C. §103(a) as obvious over DaiNippon as applied to claims 44-46, 51, 57, and 58 above, and further in view of Fry (U.S. Patent No. 4,124,554). The Examiner contends that it would have been obvious to one skilled in the art at the time of the applicants' invention to use bisphenol A instead of bisphenol F in DaiNippon because Fry exemplifies the use of bisphenol A in making similar phenol-formaldehyde resins and because the use one old, well known bisphenol known to be useful in making phenol-formaldehyde resins for another is within the expected skill of a worker in the art.

This rejection is traversed, and reconsideration is respectfully requested.

As discussed above, DaiNippon does not expressly disclose that their reaction mixture reaches a water tolerance of 500%. Additionally, neither DaiNippon nor Fry teach the importance of adding the bisphenolic compound to a mixture after the mixture has reached a water tolerance of about 400 to about 1100%. Since neither reference does not teach the

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• importance of adding a bisphenolic compound to a reacting resole resin when the water tolerance is about 400 to about 1100 %, combining the references does not yield the invention claimed by claim 50.

New Claim 65 has been added, combining the limitations of original Claim 1 and Claim 5. Because Bender neither teaches nor suggests the use of water, acetone, methylethylketone, isopropyl alcohol or phenol as solvents, Claim 65 is neither anticipated by Bender nor is it rendered obvious by Bender in combination with the other references considered by the Examiner. Claim 65 adds no new matter not previously considered by the Examiner. Accordingly, Claim 65 is also in condition for allowance.

In view of the above, applicants respectfully request withdrawal of this rejection.

Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,



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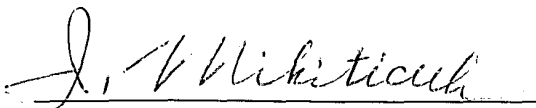
Date: August 21, 2003

#### CERTIFICATE OF MAILING

I hereby certify that this REPLY TO OFFICE ACTION OF MAY 21, 2003 (along with any documents referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

Date:

August 21, 2002



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